

## **REMARKS**

Claims 1-3, 5-16, and 21-31 were pending in this application prior to entry of the present amendments. Claims 14-16 and 21-31 were withdrawn in the Response to the Restriction Requirement filed on February 13, 2009. Claims 4 and 17-20 were cancelled in a previous action without prejudice. Applicants reserve the right to pursue the subject matter of the cancelled claims at a later date. New Claim 32 has been added by this paper. The present amendments do not add new matter.

### **Election/Restriction**

The Office Action maintains that Claim 1 is drawn to a non-elected invention (“a prosthetic limb”) and Applicant maintains that this objection is improper. Nevertheless, Applicant has amended Claim 1 to address this objection. As discussed during the interview, Applicant understands that the objection will be withdrawn.

### **Rejection under 35 U.S.C. § 103**

The Examiner rejected Claims 1-3 and 5-13 under 35 U.S.C. § 103(a) as being unpatentable over Daniels (US 6,045,076) in view of Chu (U.S. 5,831,417). Applicant respectfully traverses these rejections and the assertions made in the Office Action on what the cited art shows or teaches. Applicant refers to detailed descriptions of these references in Applicant’s previous response.

The Office Action argues that Chu recites “two SMA actuators... [that] would remain unchanged upon removal of [a] current.” However, the Office Action fails to indicate how this is taught by Chu. As Applicant noted in the previous Amendment, Chu only states that “[i]f a decision is made to tighten up the drag” then current is applied to 305A. It does not say what happens when this current is turned off.

Even further, Applicant indicated that elements 305A and 305B of Chu function to the contrary. For example, Applicant showed that SMA 305c does change upon removal of current, allowing for “short electrical pulses” to create “short and crisp contractions.” Applicant submits that Chu, on the balance, indicates that SMAs 305A, 305B, and 305C act in a similar way. The Office Action presents no evidence to rebut this.

Nevertheless, Applicant now presents further evidence that the SMAs in Chu act in a similar manner, changing upon the removal of current. For example, at Column 4 Lines 12-15 Chu recites that “[t]he electronics of the system can be designed to cut off current 107... and SMA wire 105 then returns to the limp, martensitic state,” regarding the example of Figures 3, 3A-3C. Further, regarding Figure 4, the SMAs 205A, 205B are used to control a derailleur gear for bicycles, to shift the bike between gears. Typically, bicycles have a multitude of gears that would require a sequence of discreet impulses to move between each gear sequentially. Such discreet impulses clearly imply SMAs 205A, 205B that return to their previous state upon removal of current. Thus, Applicant submits that Chu provides **no teaching of any SMA actuator that remains unchanged upon removal of current**.

For at least these reasons, Applicant respectfully submits that the Office Action fails to show that SMAs 305A, 305B meet the limitations of pending Claim 1. Thus, Applicant respectfully submits that independent Claim 1 is allowable over the cited references. As Claims 2-3 and 5-13 depend from Claim 1 and recite additional distinguishing features, Applicant respectfully submits that Claims 2-3 and 5-13 are likewise allowable over Daniels in view of Chu as each of these claims recites a unique combination of features not taught or suggested by the cited art. The arguments provided above shall supersede Applicant’s previous arguments, to the extent that they conflict.

#### **New Claim**

New Claim 32 has been added. Applicant respectfully submits that this claim is allowable over the cited references. For example, as discussed during the interview and agreed by the Examiner, the cited references fail to teach “a plurality of shape memory alloy rods arranged in parallel.” No new matter has been added.

#### **CONCLUSION**

Applicants submit that the claims are in condition for allowance and respectfully request the same. Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather,

any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

Furthermore, any remarks in support of patentability of one claim should not be imputed to any other claim, even if similar terminology is used. Any remarks referring to only a portion of a claim should not be understood to base patentability on that portion or that the limitation discussed is essential or critical; rather, patentability must rest on each claim taken as a whole. Applicants respectfully traverse each of the Examiner's rejections and each of the Examiner's assertions regarding what the prior art shows or teaches, even if not expressly discussed herein. Although changes to the claims have been made, no acquiescence, disclaimer or estoppel is intended or should be implied thereby; such amendments are made only to expedite prosecution of the present application and are without prejudice to the presentation or assertion, in the future, of claims relating to the same or similar subject matter. Applicants may not have presented in all cases, arguments concerning whether the applied references can be properly combined or modified in view of the deficiencies noted above, and Applicants reserve the right to later contest whether the cited references can be properly combined or modified.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicants' attorney in order to resolve such issue promptly.

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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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AMEND  
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